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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,942	08/28/2003	Itzhak Bentwich	050992.0300.CPUS06	1941
37808 7590 02/22/2007 ROSETTA-GENOMICS c/o PSWS 700 W. 47TH STREET SUITE 1000 KANSAS CITY, MO 64112			EXAMINER VIVLEMORE, TRACY ANN	
			ART UNIT	PAPER NUMBER
			1635	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/22/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/604,942

Applicant(s)

BENTWICH, ITZHAK

Examiner

Tracy Vivlemore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21, 23, 25, 28, 29 and 32-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 23, 25, 28, 29 and 32-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/29/06</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Any rejection or objection not reiterated in this Action is withdrawn.

#### ***Response to arguments: Priority***

The priority date accorded the disclosure of SEQ ID NO: 37404 is December 5, 2002, the filing date of application 10/310,188.

Applicant asserts the instantly claimed sequences appear in the '778 application as SEQ ID NOs: 20308 and 20309. However, the '778 application does not have these SEQ ID NOs; the sequence listing of the '778 application contains only 17,608 sequences.

#### ***Response to arguments: Double Patenting***

Claims 21, 23, 25, 28, 29 and 32-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 10, 13, 14 and 16 of copending Application No. 10/535,164.

This provisional rejection is maintained for the reasons set forth in the office action mailed October 30, 2006.

Claims 21, 23, 25, 28, 29 and 32-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 8, 11, 12 and 14 of copending Application No. 10/605,838.

This provisional rejection is maintained for the reasons set forth in the office action mailed October 30, 2006.

Furthermore, the following serial numbers of co-pending applications contain claims in which an obviousness-type double patenting rejection might be applied or contain claims for which it cannot be determined if the claimed sequences conflict:  
11/511,035 11/384,049 11/709,691 10/708,953 10/536,560 10/605,840 10/709,572  
10/709,739 11/130,649 10/604,985 10/605,923 10/707,003 10/707,147 10/707,975  
10/708,204 10/708,951 10/708,952 11/418,870 10/604,726 10/604,926 10/604,943  
10/604,945 10/604,984.

This provisional rejection is maintained for the reasons set forth in the office action mailed October 30, 2006.

Applicant argues these provisional rejections should be withdrawn due to the assertion that the claims are now in condition for allowance. Because the claims are not allowed, the provisional rejections stand.

### ***Claim Objections***

Applicant is advised that should claim 21 be found allowable, claim 29 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof, if claim 23 is found allowable claim 33 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof and if claims 40 and 41 are found allowable claims 43 and 45 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 29 is directed to a probe comprising a nucleic acid that recites limitations identical to those recited in claim 21; claim 33 is directed to a probe comprising a nucleic acid that recites limitations identical to those recited in claim 23. Similarly, claims 43 and 45 recites limitations identical to those recited in claims 40 and 41, respectively. Because claims 29 and 33 do not recite any additional components, the subject matter of claim 29 is the same as claim 21 and the subject matter of claim 33 is the same as claim 23. Also, because claims 43 and 45 do not recite any additional components, the subject matter of claim 43 is the same as claim 40 and the subject matter of claim 45 is the same as claim 41.

### ***Response to arguments***

Applicant requests the previous objection to claim 29 be withdrawn, asserting that as amended claims 21 and 29 are distinct. This argument is not persuasive

because each of these claims recites identical limitations and are thus directed to identical subject matter.

***Claim Rejections - 35 USC § 112***

Claims 21, 23, 25, 28, 29 and 32-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Limitation (c) of claims 21 and 23 has been amended to recite a sequence that is at least 80% identical to the nucleic acid of (a). Additionally, claims 28 and 29 as well as new claims 32 and 33 recite a similar limitation. It is noted that contrary to the arguments presented by applicant, the previous action did not address the question of support for the limitation "at least 80% identical" as this limitation was not present in the claims at the time the previous action was mailed. New claims 34-39 depend from one of claims 21, 23, 28, 29, 32 or 33 and recite sequences that are 90% identical to the nucleic acid of (a).

Applicant points to paragraphs 20 and 22 as providing support for nucleic acids capable of modulating expression of target genes. However, while these paragraphs contemplate that RNAs encoded by viral genes can be used to modulate gene expression, they do not describe any necessary degree of identity with the claimed

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sequences and does not provide support for the genus of compounds having 80% or 90% identity to SEQ ID NO: 37404.

Applicant further points to table 2 as showing possible binding of 16 of 20 nucleotides between SEQ ID NOS: 37404 and 37410. Applicant concludes that because a sequence 80% identical to 37404 is sufficient to target the binding site of SEQ ID NO: 37410, the recitation of "at least 80% identical" in claim 21 is supported by the application as filed. This argument is not persuasive because the complex illustrated in applicant's remarks does not describe a sequence that is 80% identical to SEQ ID NO: 37404, but describes that a portion of SEQ ID NO: 37404 itself forms a complex wherein 80% of the nucleotides of that region hybridize to SEQ ID NO: 37410. The genus of sequences that consist of 18-24 nucleotides that are 80% identical to SEQ ID NO: 37404 is very large and there is nothing in the specification as filed that would convey to one of skill in the art that applicant contemplated the limitation "at least 80% identical to SEQ ID NO: 37404" at the time of the invention. While SEQ ID NO: 37410 might be considered disclosure of a sequence that is 80% identical to a region of the complement of SEQ ID NO: 37404, disclosure of this single sequence is not disclosure of a representative number of species of the genus of sequences encompassed by the claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Vivlemore whose telephone number is 571-272-2914. The examiner can normally be reached on Mon-Fri 8:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Schultz, can be reached on 571-272-0763. The central FAX Number is 571-273-8300.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Tracy Vivlemore  
Examiner  
Art Unit 1635

TV  
February 12, 2007



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PRIMARY EXAMINER